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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,428	08/30/2000	Brian Berson	1697P	2572

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	4

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/651,428

Applicant(s)

BERSON ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: the application filed on 8/30/00.
2. Claims 1-20 are pending in the case. Claims 1, 9, and 15 are independent claims.

Specification

3. It is requested that Applicants update the status of the co-pending U.S. application mentioned in the specification (page 1, lines 5-7).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen (US Pat No. 6,278,465 B1, 8/21/01, filed 6/23/97).

Regarding independent claim 1, Nielsen discloses:

- forming a database of font specifications (col 5, line 53 to col 6, line 27 and figure 5B, #524, #528, figure 5C, #542, #548: the Font Size Preference Database storing Font Sizes which are font specifications shows that such a font database is formed)

- accessing the database when saving and opening documents to ensure usage of proper fonts (figure 4 and col 5, lines 14-28: accessing the font size database when *opening documents* – *retrieving the font for displaying* the requested document; figures 5C #542-#550 and col 5, lines 29: accessing the database when *saving* documents (record the font size for the URL in the database))

Regarding claim 2, which is dependent on claim 1, Nielsen discloses accessing the database when storing further comprising obtaining a font list for a document being saved, and determining whether font specifications for each font in the font list exist in the database (figure 5C, #548 Ask user if new font size should *be recorded or not in Preference Database* where the database includes a font list for documents; figures 3A, 3C).

Regarding claim 3, which is dependent on claim 2, Nielsen discloses that when the font specifications do exist, the method further comprises retrieving the font specifications for each font from the database (figure 4, #410 URL found in size preference DB?, #430 Display file using the font stored in database: the fact that the system checks to see if the URL found in size preference database and if yes, displays file using the font stored in the database shows that the font specification of said URL in conjunction with the URL is retrieved for displaying file using said font stored in the database; col 5, lines 14-28).

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Regarding claim 4, which is dependent on claim 3, Nielsen discloses that when the font specifications do not exist, the method further comprises creating the font specifications for each font (figure 5C, #548 and col 7, lines 45-59: the fact that if the URL does not currently exist in the font size preference database, the user is asked if *the new font size* should be recorded in the Font Size Preference Database shows a creating of the font specification for a new font for a file document).

Regarding claim 5, which is dependent on claim 4, Nielsen discloses writing the font specifications into the document, and saving the document (figure 5C, #542-#554: if the URL is not in the font preference database, then *the new font is recorded* for the document in the preferred font size database; this shows that the preferred font size, which is the font specifications for the document referred by the URL, is written to the document and saved in the database with the URL).

Regarding claim 6, which is dependent on claim 1, Nielsen discloses accessing the database when opening documents further comprises retrieving font specifications from a document being opened (figure 4; col 5, lines 14-28: “ .. if the URL was found in the Size Preference Database then the requested document is displayed using the preferred font size retrieved from the database ...”).

Regarding claim 7, which is dependent on claim 6, Nielsen discloses searching the database to locate each font specified by the font specifications in the document (col 5,

lines 14-28: the fact that based on the query, the URL was found in the Size Preference Database shows searching the database is carried out to locate the font specification for the document; "if the URL was not found in the Size Preference Database 410, *then a search (see FIG. 8) is made of the Sub-Site Database ...*").

Regarding claim 8, which is dependent on claim 7, Nielsen discloses retrieving each font located (col 5, lines 14-28: the font for the requested document is retrieved either in the Size Preference Database or the Sub-Site Database).

Claims 9-14, 15-20 are for a system and a computer readable medium of method claims 1-8, and are rejected under the same rationale.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Simon (US Pat No. 6,065,008, 5/16/00, filed 10/1/97).

Colletti (US Pat No. 5,990,907, 11/23/99, filed 12/12/96).

Colletti (US Pat No. 6,323,865 B1, 11/27/01, filed 11/22/99, priority 12/15/95).

Adamske et al. (US Pat No. 6,615,234 B1, 9/2/03, filed 5/11/99).

Heckman et al. (US Pat No. 5,291,243, 5/1/94).

Patel et al. (US Pat No. 6,426,751 B1, 7/30/02, filed 4/1/99).

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Chen et al., Word Spotting in Scanned Images Using Hidden Markov Models, IEEE 1993, pages V-1 to V-4.

Gruman, Adobe Acrobat 2.0, Macworld San Francisco Mar 1995, Vol. 12, Iss. 3, pages 59-60.

Bowman, Adobe Type Manager Deluxe 4.0 for Windows 95 Now Available, PR Newswire, New York, Jul 16, 1996, page 1.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

clh
2/2/04



STEPHEN S. HONG
PRIMARY EXAMINER